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Appl. No. 08/939,064

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### R E M A R K S

Reconsideration is respectfully requested.

#### **Procedural History**

Claims 1-6 were previously rejected as being obvious in view of Elliott et al, U.S. patent no. 5,621,904. In response, Applicant did not amend the claims. Rather, Applicant argued that Elliott teaches away from the claimed invention.

Then, the claims were finally rejected on the same basis. In response to the final rejection, Applicant reminded the Examiner that a modification to a primary reference is not obvious merely because the modification "allows" a user to perform an additional function, unless the prior art suggested the modification. Again, Applicant did not amend the claims.

Applicant then filed the present CPA in order to further prosecute claims 1-6 and to prosecute additional claims 7-12 which are directly parallel to claims 1-6 but which were added merely to cover different forms of the invention.

#### **Obviousness Rejection -- Elliott and Southgate**

Now, claims 1-2, 5-7 and 10 are rejected as being obvious not over Elliott alone, but rather over the combination of Elliott and Southgate. As is discussed in detail below, it is once again submitted that not only does the combination of Elliott and Southgate not yield the claimed invention but, also, the Examiner's stated motivation for combining Elliott and Southgate is not a proper "suggestion" for combining the references. For these reasons, Applicant respectfully traverses the rejection.

In advancing the rejection, the Examiner recognizes a shortcoming of Elliott, namely that Elliott does not teach details of how the "subwindow" is positioned. The Examiner contends that Southgate makes up this shortcoming. In particular, the Examiner states that "Southgate discloses a user interface control allow [sic] the user to move from one area to area". Even if the Examiner is correct in his characterization of what Southgate

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discloses (upon which Applicant does not take a position), the combination of Elliott and Southgate does not yield what is claimed.

Taking claim 1, for example, one feature recited in this claim is automatically changing, if a separated distance of said sub window displayed at a display position moved by said display position moving means to said main window is within a preset predetermined value, arrangement of said sub window to a position adjacent to said main window.

An example of this feature can be found in Applicant's specification at page 82 et seq, with reference to Applicant's Figs. 28-31. The Examiner's attention is particularly drawn to step S52 through about step S55 of the Fig. 28 flowchart. Is it the Examiner's contention that Southgate's Abstract and claim 2 disclose such a feature? If so, Applicant does not agree and Applicant would appreciate the Examiner more specifically explaining how Southgate's Abstract and claim 2 are contended to disclose the above-mentioned "automatically changing . . . [based on] predetermined distance" feature of claim 1.

As for the rejection of claim 2, the Examiner uses impermissible hindsight reasoning in advancing this rejection. That is, in contending that the invention would be obvious, the Examiner states in part that "organizing the display window this way in some cases may maximize the display area". Basically, the Examiner is saying that the combination is obvious because it yields an advantageous result. If this were the standard of obviousness, then any development whose parts were old and yielded an "advantageous result" (most inventions) would be obvious. Rather, it is well-established that the suggestion to combine must come from either the cited references or from knowledge held by one of ordinary skill in the art. The Examiner appears to agree that the suggestion does not come from the references, and the Examiner does not even allege that knowledge held by one of ordinary skill in the art would suggest combining Elliott with Southgate. Therefore, the Examiner's obviousness contention is seriously deficient.

As for the rejection of claims 3-4, 8-9 and 11-12, it is submitted that these claims are patentably distinct from the references cited by the Examiner because the claims on which they depend are patentably distinct over the references cited in rejecting those claims.

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For these reasons, it is respectfully submitted that claims 1-12 are allowable over the references cited by the Examiner.

Title

The Title has been changed to be more indicative of the claimed subject matter.

CONCLUSION

It is respectfully submitted that this application is in condition for allowance. Notice to that effect is earnestly solicited.

Respectfully submitted,

LIMBACH & LIMBACH L.L.P.

A handwritten signature in black ink, appearing to read "ALAN S. HODES".

Dated: 9/1/99

By:

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